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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,340	01/18/2002	Lou Chauvin	83304EF-P	9965

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EXAMINER

ZHONG, CHAD

ART UNIT

PAPER NUMBER

2152

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/051,340

Applicant(s)

CHAUVIN ET AL.

Examiner

Chad Zhong

Art Unit

2152

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 10/051,340 of the same invention.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-19 are presented for examination.
2. It is noted that although the present application does contain line numbers in specification and claims, the line numbers in the claims do not correspond to the preferred format. The preferred format is to number each line of every claim, with each claim beginning with line 1. For ease of reference by both the Examiner and Applicant all future correspondence should include the recommended line numbering.
3. Applicant is required to update the status (pending, allowed, etc.) of all parent priority applications in the first line of the specification. The status of all citations of US filed applications in the specification should also be updated where appropriate.

Claim Rejections - 35 USC § 112, second paragraph

4. Claim is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - a. The claim language in the following claims is not clearly understood:
 - i. As per claim 2, line 1, it is not clearly understood what is meant by claim 2 referencing to itself (i.e. does the applicant mean to say 'claim 1'?).

Double Patenting

5. Claims 1-19 provisionally rejected under the judicially created doctrine of double patenting over claims 1-21 of copending Application No. 10/050,979. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

both applications discloses a remote photograph development network. Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schmeller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371 (c) of this title before the invention thereof by the applicant for patent.

7. Claims 1, 3-7, 9-10, 12-16, and 18-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Smart et al. (hereinafter Smart), US 2003/0208691.

8. As per claim 1, Smart teaches a method for ordering of digital photo services among a plurality of order terminals each being associated with one of a plurality of business entities, using a digital image provided on a digital storage device associated with one of a plurality of digital storage device providers, comprising (Fig 2, wherein the photos from the client computer/camera is printed at a remote printer service):

maintaining information with respect to business relationships between said plurality of digital storage device providers and said plurality of business entities ([0116]; table 1, [0095-0101], criteria

relating to speed/cost/quality of work is the basis for establishing proper business relationship between the client and a print shop service);

providing a digital storage device at one of said order terminals (Fig 2, item 102; [0042], [0045], where the computer terminal provides the storage device); and

providing an offering at said one order terminal based on a business relationship between the business entity associated with said one order terminal and said digital device provider associated with said digital storage device ([0053]; [0077-0078]; [0116]; table 1; [0095-0101], the database directory displays different offering or quality of photos able to replicate at a particular service site, the client is able to select from such offering database directory to perform a photograph printout).

9. As per claim 3, Smart teaches:

said offering is displayed in a presentation format that is also based on said business relationship (pg 10, [0123], wherein the resolution of the printers of different vendors varies, user display as well as printout of the photos are sent to the printer(s) or business(es) that are able to supply the requested resolution; [0081-0082]; [0088], offering for print services is displayed to the user, the printer service is identified as compatible or a 'match' to user's desired quality of print out).

10. As per claim 4, Smart teaches:

said order terminal comprises one of the following:

an automated teller machine

a photo kiosk

a personal computer ([0042]; [0045-0047]; Fig 2, item 102, 148);

a wireless imaging device

11. As per claim 5, Smart teaches:

said digital storage device comprises one or more of the following:

optical disc;

magnetic floppy disc;

memory card;

digital camera (Fig 2, item 102).

12. As per claim 6, Smart teaches:

said one order terminal provides access to one or more of the following services:

local printing of digital images;

remote printing of digital images on-line storage of digital images (Fig 2, item 102, camera inherently has memory to store digital images, further, user need to select camera images from camera's memory to perform print services; Fig 2. where the digital images are printed out at remote printing services);

providing digital storage media containing digital images (Fig 2, item 102, camera inherently has memory to store digital images, further, user need to select camera images from camera's memory to perform print services);

providing associated goods and/or services with respect to hard copy prints (Fig 2, wherein the hard copy prints are supplied at remote printers, item 104 and 106).

13. As per claim 7, Smart teaches:

said digital storage device includes a code which identifies the associated service provider (table 1, see for example, I/O matching wherein the device attributes or codes are compared to obtain the optimum printing service).

14. As per claim 9, Smart teaches:

said business relationships are maintained in a services directory by a service manager (pg 3, [0053];

pg 10, [0127], wherein additional services is requested on behalf of the client, thus the business relationship between the services is maintained in a services directory; pg 3, [0053], service relationships or service descriptions/information necessary for establishment of such relationship is maintained within service directory; pg 10, [0127], wherein additional services is requested on behalf of the client by consulting its own record of available services, thus the business relationship between the services is maintained in a services directory on the network; [0078-0079], where relationships between different services are maintained in a directory listing in Fig. 3).

15. As per claim 10, Smart teaches a system for ordering of digital photo services by a user using one order terminal from a plurality order terminals each being associated with one of a plurality of business entities and using a digital image provided on a digital storage device associated with one of a plurality of digital storage device providers, comprising:

a control system for maintaining information with respect to business relationships between said digital storage device providers and said plurality of business entities([0116]; table 1, [0095-0101], criteria relating to speed/cost/quality of work is the basis for establishing proper business relationship between the client and a print shop service);

said order terminal being used by said user displaying an offering based on a business relationship between the business entity associated with said order terminal and said digital device provider associated with said digital storage device ([0081-0082]; [0088], offering for print services is displayed to the user, the printer service is identified as compatible or a 'match' to user's desired quality of print out; [0042]; [0045-0047] users use the computer terminals to order printouts at a remote print shop service).

17. As per claims 12-16, 18, the claims are rejected for the same reasons as rejection to claims 3-7, 9 above respectively.

18. As per claim 19, claim 19 is rejected for the same reasons as rejection to claim 1 and 10 above.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 2, 8, 11, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smart et al. (hereinafter Smart), US 2003/0208691, in view of in view of what was well known in the art.

21. As per claim 2, Smart does not explicitly teach:

an offering price based on said business relationship. Official Notice is taken (see MPEP 2144.03) an offering price based on business relationship was well known and routinely used for agreeing for types of services offered, acting as a binding agreement between purchaser and provider, further, price based on business relationship is a well known criteria prior to offering an e-commerce service. It would have been obvious to one of ordinary skill in the art to include an offering price based on business relationship with Smart because it would provide for an electronic commerce environment, by allowing for a price agreement for a particular service.

22. As per claim 11, the claim is rejected for the same reasons as rejection to claim 2 above.

23. As per claim 8, Smart teaches said business relationships include friendly, neutral, relationships ([0170-0171]; [0175], an example as shown in Smart teaches user sending request to a remote print shop service to print out high photographs. Since Applicant does not explicitly define business relationship in the specification, Examiner will interpret business relationship as relationship between two parties, i.e.

requestor and service provider. Additionally, 'shop' has the meaning of "a mercantile establishment for the retail sale of goods or services", thus, the print shop service of Smart offers a business relationship between the requestor and the print shop service. The relationship is friendly because the print shop is providing a desired service to the user; the relationship is neutral because the relationship is based upon a service agreement between user and the service provider, i.e. the provider can offer print outs at a certain range of resolution).

However, Smart does not explicitly teach hostile relationships. Official Notice is taken (see MPEP 2144.03) hostile / competitive relationship was well known and routinely used for maintaining competition between businesses practicing in the similar area of practice at the time of the invention was made. It would have been obvious to one of ordinary skill in the art to include hostile relationships with Smart because it would provide for fair business practices, enabling fair competition between plurality of businesses and ensure reasonable pricing for the end customers.

24. As per claim 17, the claim is rejected for the same reasons as rejection to claim 8 above.

Conclusion

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents and publications are cited to further show the state of the art with respect to "SYSTEM, METHOD AND SOFTWARE PRODUCT FOR ORDERING IMAGE PRODUCTS USING IMAGES STORED ON A DIGITAL STORAGE DEVICE FROM A PLURALITY OF ORDER TERMINALS".

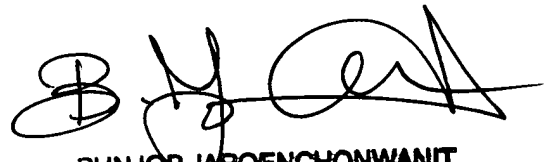
- | | | |
|------|-----------------|----------------|
| i. | US 2003/0011801 | Simpson et al. |
| ii. | US 6195667 | Duga et al. |
| iii. | US 5764866 | Maniwa, Yoshio |

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chad Zhong whose telephone number is (571)272-3946. The examiner can normally be reached on M-F 7:15 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAROENCHONWANIT, BUNJOB can be reached on (571)272-3913. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CZ
December 5, 2005



BUNJOB JAROENCHONWANIT
PRIMARY EXAMINER